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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/728,340
Filing Date: December 01, 2000
Appellant(s): VICKNAIR ET AL.

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Stephen T. Schreiner (Reg. # 43,097)
<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/25/2008 appealing from the Office action

mailed 7/24/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,930,778	Geer	7-1999
6,457,006	Gruenwald	9-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

Status of Claims:

Claims: 7, 11-35, 42 and 46-66 are canceled.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6, 8-10 and 36-41 and 43-45 remain rejected Geer (US 5,930,778) in view of

Gruenwald (US 6,457,006).

Re. Claims 1, Geer discloses a system for expedited processing of checks and cash

items received by a payee, electronic files that mirror paper cash letters and detail

records [Figures 1-2; col. 1 line 1 to col. 6 line 20],

receiving an electronic cash presentment (ECP or transmission of the

transactional check data) file, the ECP file containing first records representing

paperbased banking transactions [col. 2 lines 4-15; col. 4 line 26 to col. 5 line 9; col. 7

lines 25-61; col. 9 lines 1-10; col. 18 lines 1-18],

for each of the first records, assigning a unique first item sequence number to each

respective first record [col. 7 lines 38-58],

receiving the paper-based banking transactions after having received the ECP

file, [col. 4 line 45 to col. 5 line 10; col. 10 lines 50-57],

generating second records representing the paper-based banking transactions

[col. 15 lines 17-19],

generating digital images of the paper-based banking transaction [col. 4 lines 26-

42; col. 8 lines 9-67];

for each of the second records, assigning a unique second item sequence

number to each respective second record [col. 13 lines 44-49], and

correlating the first and second records [col. 1 lines 58-65 – see reconcile the

invoice and the payment].

Geer does not explicitly disclose discarding the second item sequence numbers

such that the second records are indexable according to the first item sequence

number, wherein the second records and the digital images (record) are linked to the

records by the first item sequence number.

However, Gruenwald discloses this feature [Figures 7, 10, 12; col. 1 line 60 to

col. 2 line 8; col. 2 lines 38-47; col. 4 lines 55-59; col. 10 lines 48-62 – see correlation

across various data fields] to remove duplicate, defective or not used records and

improve the memory usage of the database. It would have been obvious at the time the

invention was made to a person having ordinary skill in the art to modify the disclosure

of Geer and include discarding the second item sequence numbers such that the

second records are indexable according to the first item sequence number, wherein the second records and the digital images (record) are linked to the records by the first item sequence number, as disclosed by Gruenwald, to use standard database maintenance procedure and discard duplicate or redundant information to improve memory usage and the performance of the database.

Re. Claim 2, Geer discloses further comprising performing financial processing with respect to each of the first records [Geer -col. 3 lines 30-55; col. 4 lines 26-42].

Re. Claim 3, Geer discloses wherein the financial processing comprises posting the banking transaction [Geer- col. 3 lines 30-55; col. 4 lines 26-42].

Re. Claim 4, Geer discloses wherein the step of correlating the first and second records further comprises performing a proofing process [col. 1 lines 58-65; col. 5 lines 10-13]

Re. Claim 5, Gruenwald, further discloses prior to the proofing process, sorting the ECP file (raw data) according to a key to generate an index file, wherein the order of the seconds is thereby irrelevant in the proofing process [Figure 12; col. 1 lines 18-36; col. 8 line 52 to col.9 line 5]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Geer, and include the above feature, as disclosed by Gruenwald to identify duplicate data between the fields.

Re. Claim 6, Geer discloses wherein the key is selected from the group consisting an account number, a transit number, amount, check number, posting date, the first item sequence number and a payor bank number, each being associated with the paperbased banking transaction [Geer - col. 7 lines 38-62].

Re. Claim 8, Geer discloses further comprising storing the digital images in an archive [col. 8 lines 10-67; col. 15 17-19; col. 17 lines 5-8].

Re. Claim 9, Geer discloses further comprising generating first digital images of paperbased banking transactions that were not represented in the ECP file (electronic files that mirror paper cash letters and detail records) [col. 4 lines 26-42; col. 8 lines 9-67].

Re. Claim 10, Geer discloses generating second digital images of the paper-based banking transactions that were represented in the ECP file, and storing the first and the second digital images in an archive [col. 8 lines 9-67; col. 15 lines 7-19; col. 17 lines 5-8].

Re. Claim 36, claim 36 is rejected with same rational as claim 1.

Re. Claim 37, claim 37 is rejected with same rational as claim 2.

Re. Claim 38, claim 38 is rejected with same rational as claim 3.

Re. Claim 39, claim 39 is rejected with same rational as claim 4.

Re. Claim 40, claim 40 is rejected with same rational as claim 5.

Re. Claim 41, claim 41 is rejected with same rational as claim 6.

Re. Claim 43, claim 43 is rejected with same rational as claim 8.

Re. Claim 44, claim 44 is rejected with same rational as claim 9.

Re. Claim 45, claim 45 is rejected with same rational as claim 10.

(10) Response to Argument

Brief Description of Prior art (Primary Reference)

Geer teaches conventional check clearing system [col. 2 lines 4-23], electronic

check present system and electronic cash letter [col. 7 lines 32-35 "electronic cash

letter"; col. 4 lines 27-32 - see reference to Stephens et al. US 5,237,159[1] titled

"ELECTRONIC CHECK PRESENTMENT SYSTEM"], and system for expediting the

clearing of financial instruments (checks) [col. 4 lines 46-54; col. 9 lines 26-45].

In response to appellant's argument, recited on page 10 and page 12 (Geer

focuses), that Geer is non-analogous art, it has been held that a prior art reference must

either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to

the particular problem with which the applicant was concerned, in order to be relied

upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443,

24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Geer teaches the checks are collected

and processed remotely from the payee bank (depository bank), where the process

includes scanning, sorting, extracting check information, generating a data file and

electronic cash letter from extracted file and transmitting the data file and electronic

cash to payee bank for additional processing. It would have been obvious at the time

the invention was made to a person having ordinary skill in the art that whether the

above process is done at remote location or scanning room of the depository bank and

the generated data file is transmitted to bank's computer for additional processing are

not patentable distinguished. In both locations the same function is performed and the

same result is achieved, a check data file received at the depository bank for further

processing *[see Geer col. 9 lines 52-64; col. 11 lines 45-55].*

In response to appellant's argument, recited on page 10, that "Geer and Gruenwald,

alone or in combination, do not teach, suggest, or imply all of the features and

limitations of the claim."

     Appellant has failed to point out any of the missing limitation which is not taught

by the combination of primary reference (Geer) or secondary reference (Gruenwald).

See final office action paper number 20070718a or Ground of Rejection, above.

Note: The Examiner's response is focused/limited only to the limitations which

are claimed in independent method claim 1 and independent system claim 36.

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[1] Stephens et al. (US 5,237,159) is a prior art submitted by the applicant with IDS (5/23/2005) and considered by the

In response to appellant's argument, recited on page 13, that Geer does not teach or

fairly suggest "receiving an electronic cash presentment (ECP) file, the ECP file

containing first records representing paper-based banking transactions".

With broadest reasonable interpretation of the claimed limitations, without

reading limitations of the specification into the claim, Geer discloses receiving an

electronic cash presentment (electronic cash letter) file, the ECP (electronic cash letter)

file containing first records representing paper-based banking transactions, *see at least*

[col. 2 lines 4-15 "a typical cash letter contains routing information, the number and total dollar amount

of the checks *in a particular bundle, and optional additional information"*, col. 9 *lines 18-45* "The

electronic check information is sorted and routed via 14, with appropriate electronic information added

thereto to insure proper routing through the payment and clearing system to the appropriate payor bank.

Electronic information of the sorted checks transmitted for particular payor banks, the equivalent of a cash

letter, is included *with each electronic bundle of checks"; and "The check information from the payment*

system 12 reaches the appropriate payor banks *(**means payor receives**) 16 for proper debiting of the*

accounts of check writers 1 thus completing the payment cycle." col. 7 *lines 25-61* "included with the

electronic record *to be associated with* each check".

In response to appellant's argument, recited on page 15, that Geer fails to teach or fairly

suggests, "receiving the paper-based banking transactions after having received the

ECP file".

Geer teaches receiving the paper-based banking transactions after having

received the ECP file. *See at least [col. 5 lines 10-45* "Another embodiment of the ... sends the

paper check after processing ..."; *col. 10 lines 50-57* "*electronic transfer and processing of payments*

occur and paper checks follow at some <u>*later time for confirmation*</u>, <u>*reconciliation*</u> *and* <u>*storage by the payor*</u>

<u>*bank*</u> *and or for return to the drawer.* <u>*Paper checks in this system are truncated*</u> *at a point beyond the*

bank of first deposit, <u>*usually at the payor bank*</u>, *where the checks are stored or imaged for archival*

storage and option ally disposed.";] It would have been obvious to a person having ordinary

skill in the art that Geer implicitly teaches the paper checks are sent after electronic

cash letter (ECP), by considering the entire prior art which is 12 pages long.

In response to appellant's argument, recited on page 16, that Geer fails to teach or fairly

suggests, "generating second records representing the paper-based banking

transactions."

Geer teaches generating second records representing the paper-based banking

transactions. *See at least [col. 15 lines 17-19* "<u>*creating a second record*</u> *translatable into a*

visually perceptible image of <u>*each of said financial instruments*</u>."

In response to appellant's argument, recited on page 17, that Geer does not teach or

suggest, "correlating the first and second records".

Geer teaches correlating the first and second records, see at least [col. 1 lines

58-65 *"Internal accounting procedures of the payor reconcile the invoice and payment with the payor's*

account with payee." and *col. 10 lines 50-57 reads* "*In the example depicted in FIG. 2, electronic*

transfer and processing of payments occur and paper checks follow at some later time for confirmation,

<u>*reconciliation*</u> *and storage by the payor bank and/or for return to the drawer."* *Reconciliation of paper*

check and ECP is done only when the paper check and ECP entry is correlated otherwise payment

cannot be reconciled.]

In response to appellant's argument, recited on page 19, that Examiner admits that

Geer does not teach or fairly suggest, "discarding the second item sequence numbers

such that the second records are indexable according to the first item sequence number

wherein the second records and the digital images are linked to the first records by the

first item sequence number."

Secondary reference Gruenwald discloses discarding the second item sequence

numbers such that the second records are indexable according to the first item

sequence number, wherein the second records and the digital images (record) are

linked to the records by the first item sequence number. See at least Gruenwald *[Figure*

7 # 730 "correlate data record within set", Figure 10 #1010-1050 *(sort first/second fields and*

identify common values between them is correlating), Figure 12 (sort, common value); *Abstract*

"method for organizing raw data from one or more sources uses an improved mechanism for identifying

duplicate data between fields (e.g., columns) in the databases"; col. 1 line 60 to col. 2 line 8

"mathematical operations such as correlation functions, pattern recognition methods, or other similar

numeric methods, may be performed on these vectors to determine how content in a particular vector

corresponds to others vectors", col. 4 lines 55-59 *"duplicate data corresponding to the same supplier*

or customer may be identified and or discarded"; col. 10 lines 48-62 *].* Gruenwald discloses

discarding unnecessary data since sequence numbers are data and are redundant

data, disclosure of Gruenwald reads on this limitation. It would have been obvious at the

time the invention was made to a person having ordinary skill in the art that redundant

data can be discarded or ignored for efficiently processing, efficiently use the memory,

database maintenance, and handling of the database. Geer discloses relationship of

digital image with first record and second record *[col. 4 lines 54-61; col. 13 lines 44-49]*,

and Gruenwald discloses the relationship between the first record and second field,

therefore there is a relationship/linkage between the first record, second record and the

digital image and combination of the Geer and Gruenwald reads on this "wherein"

transitional clause.

In response to applicant's argument that there is no suggestion to combine the

references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re*

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, redundant data

can be discarded or ignored for efficiently processing, efficiently use the memory,

database maintenance, and handling of the database.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Harish T Dass/
Primary Examiner, Art Unit 3692
Monday, March 24, 2008

Conferees:

Kambiz Abdi (SPE Art Unit 3692) /K.A./

Alexander Kalinowski /A. K./

Supervisory Patent Examiner, Art Unit 3691